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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RAGONESE, ANDREA M

ART UNIT PAPER NUMBER

3743

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,358

Applicant(s)

TANAKA, DON

Examiner

Andrea M. Ragonese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on August 20, 2004 has been entered. Examiner acknowledges that **claims 1-2** have been amended.

Response to Arguments

2. Applicant's arguments, see page 4, filed August 20, 2004, with respect to the 35 U.S.C. 101 rejection of **claims 1-2**, have been fully considered and are persuasive. The U.S.C. 101 rejection of **claims 1-2** has been withdrawn.

3. Applicant's arguments, filed August 20, 2004, with respect to the rejections of **claims 1-2**, have been fully considered but they are not persuasive. Therefore, the rejections for **claim 1** under U.S.C. 102(b) and **claim 2** under U.S.C. 103(a), from Office action dated May 18, 2004, are recapitulated hereinafter, and are made **FINAL**.

4. Regarding **claim 1**, in response to applicant's argument that the prior art of record [Jacobs (US 3,682,166)] "fails to disclose or even suggest an oxygen supply, at least one conduit configured to pass through the thoracic wall and lung of a patient and a sealing device configured to provide a seal between the conduit and the thoracic wall," the Examiner respectfully disagrees. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967)

and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Specifically, as stated in the Office action of May 18, 2004, the device of Jacobs is **fully capable of being configured** to perform the function as claimed, thus meeting the claim limitation of "passing through the thoracic wall and lung of a patient." As broadly and reasonably interpreted by the Examiner, Jacobs **does disclose** an oxygen supply, as shown in Figure 5 as element **15**, which is "a source of gas under pressure **15**" which "may be compressed air, pure oxygen or air fortified with a higher percentage of oxygen than a normal atmospheric air" (column 3, lines 33-37). Jacobs also discloses at least one conduit, as shown in Figure 5 as catheter **3**, that is **fully capable of being configured** to pass through the thoracic wall and lung of a patient. Additionally, Jacobs discloses a sealing device, as broadly interpreted to be the adhesive tape, which is **fully capable of being configured** to provide a seal between the conduit **3** and the thoracic wall of a patient (column 3, lines 3-15).

5. Regarding **claim 2**, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In addition, Applicant argues that the prior art of record [Jacobs (US 3,682,166) in view of DeLuccia (US 5,402,482)] "whether taken alone or in combination fail to disclose or even remotely

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suggest an oxygen supply, valves, conduits and multiple sealing devices for providing seals between the conduit and the thoracic wall and bronchus,” the Examiner respectfully disagrees. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Specifically, as stated in the Office action of May 18, 2004, the device of Jacobs is **fully capable of being configured** to perform the function as claimed, thus meeting the claim limitations. As broadly and reasonably interpreted by the Examiner, Jacobs **does disclose** an oxygen supply, as shown in Figure 5 as element **15**, which is “a source of gas under pressure **15**” which “may be compressed air, pure oxygen or air fortified with a higher percentage of oxygen than a normal atmospheric air” (column 3, lines 33-37). Jacobs also discloses a first conduit, as shown in Figure 5 as catheter **3**, that has a first end connected to the oxygen supply **15** and a second end connected to the valve **23**. Additionally, Jacobs discloses a sealing device, as broadly interpreted to be the adhesive tape, which is **fully capable of being configured** to provide a seal between the conduit **3** and the thoracic wall of a patient (column 3, lines 3-15). The secondary reference (DeLuccia) **does disclose** a second conduit **59** having multiple branches **63**, **67**, that is **fully capable of being configured** to pass through the thoracic wall and lung of a patient.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Jacobs (US 3,682,166), as previously stated in the Office action dated May 18, 2004.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs (US 3,682,166) in view of DeLuccia, deceased et al. (US 4,502,482), as previously stated in the Office action dated May 18, 2004.

Conclusion

10. Applicant(s) should note that if any further amendment to the claims were to properly incorporate allowable subject into the claim language, thus placing this application in condition for allowance, withdrawn **claims 3-4**, drawn to an invention non-elected without traverse, should be canceled in order to expeditiously further prosecution of the instant application.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese whose telephone number is 703-306-4055 until November 17, 2004.** Examiner Ragonese can be reached at 571-272-4804 thereafter. The Examiner can normally be reached on Monday through Thursday from 8:30 am until 4:30 pm.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101 until November 17, 2004, and thereafter, at 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR



Henry Bennett
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